# REMARKS

In the above referenced office action, claims 1, 6, 11, 15, 16, and 17 are amended, claims 1-4, and 6-20 are pending in the application. Claims 5 and 21-30 are canceled. No new matter is being added.

## Rejections Under 35 USC §102(b)

Claims 1 and 11 are rejected under 35 U.S.C. §102(b) as being anticipated by *Imai, et al.* (U.S. 5,978,590). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102 in view of the recitations in claims 1 and 11 as set forth above.

Independent claims 1 and 11 include:

... a system BIOS; a server including a script associated with an identification device, an identifier and order information; a computer system coupled to the server and including a port; the identification device coupled to the port, the device including the identifier; the computer system configured to: in response to being powered up, boot by executing instructions from the BIOS; read the identifier from the device; provide the identifier to the server; in response to receiving the identifier, the server causing the identifier to be installed with the order information and the script...

On pages 2 and 3, the office action states, "The embodiments of Figs 1 and 2, the element ID storage means <u>stores the terminal as</u> taught in col. 5, line 54 and col. 6, line 32 describing these respective embodiments. However, the embodiment of Fig. 3 as shown below uses the bar code that is attached to the PC as terminal ID to provide it to the server, and Imai, for this embodiment never teaches that this terminal ID is kept inside the PC, rather it specifically teaches that "the identifier is being removed from the computer by providing it to the server and not stored into the terminal (PC) itself (col. 10, line 8-14).""

Applicants have reviewed Imai FIG. 3, col. 10, lines 8-14 and col. 10, lines 35-67 and were unable to find a reference to "identifier being removed from the computer system". As stated in the office action, Imai specifically and explicitly states "the bar coded ID is <u>attached</u> to

the PC" (col. 10, line 9) (emphasis added). The office action asserts that the ID is not <u>stored</u> inside the PC and concludes on page 3 that Imai "specifically teaches that the identifier is being removed from the computer by providing it to the server and not stored into the terminal (PC) itself". Applicants respectfully submit that since the bar coded ID is <u>attached</u> to the PC it is not apparent how the office action concludes that "the identifier is being removed from the system". The step of reading the bar coded ID with a bar code reader does not 'remove' the bar coded ID attached to the PC, as asserted by the office action. On the contrary, Imai (FIG. 3 and col. 9, lines 19-21) states, "When the assembly is completed, the hardware configuration information is written in the nonvolatile memory in the PC". Thus, Imai teaches away from the 'removing the identifier from the computer system' and the 'reuse' limitation of the identifier recited in Claims 1 and 11.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection *Imai, et al.* reference must contain all of the claimed elements of independent claims 1, 11 and 21. However, the invention as claimed, is not shown or taught in this reference. Therefore, the rejection is unsupported by the art and should be withdrawn.

Therefore, independent claims 1 and 11 and claims dependent therefrom are not anticipated by the cited art and are therefore submitted to be allowable.

<u>Rejections Under 35 USC §103(a)</u>

Claims 3, 13 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai, et al.* in view of *Oki, et al.* (U.S. 5,859,969). Claims 7, 17 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai, et al.* as applied to 6, 16 and 26 above in view of *Donohue* (U.S. 6,202,207). Claims 8-10, 18-20 and 28-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai, et al.* in view of *Chiloyan, et al.* (U.S. Pub. 2002/0095501). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Claims 3, 7 and 8-10 depend from independent Claim 1, claims 13, 17, and 18-20 depend from independent claim 11. For reasons similar to those stated above in regard to claims 1 and 11, Imai does not teach or suggest the claim invention. Because, Imai teaches

away from the claimed invention, there would be no motivation to combine Imai, Oki, Donohue and Chiloyan considered individually or in combination.

As the PTO recognizes in MPEP § 2142:

> ...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The combined references fail to teach or suggest the claimed combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

Therefore, independent claims 1 and 11 and the claims dependent therefrom are submitted to be allowable.

## CONCLUSION

In view of the above, it is respectfully submitted that claims 1-4 and 6-20 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

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